

REMARKS

Claims 1, 7, and 13-19 have been amended. In view of the above-amendments and the following remarks, Applicant hereby respectfully requests reconsideration of the application, and allowance of claims 1-29.

Initially, Applicants would like to direct the Office's attention to an error in the Office Action. On page 2 of the Office Action, the Office states that "the response filed on 9/7/2004 has been received made of record." This error was repeated on the Office Action Summary wherein the Office also indicated that the Office Action was responsive to communications filed on September 7, 2004. However, as was confirmed by a telephone conference with Examiner Salad on April 22, 2005, there was no communication filed September 7, 2004 on the record, and instead, the Office Action is responsive to the Amendment filed on August 4, 2004.

The Office has rejected claims 13-18 under 35 U.S.C. § 101 because the claims are directed "information readable media" not tangible embodied on a computer readable medium. In addition, the Office states that a statutory product with descriptive material must include positive recitation of the computer readable medium. Applicants adopt the Office's recommendation and amend claims 13-18 herein to recite "a computer readable medium having instructions stored thereon for managing electronic messages," which clearly satisfies 35 U.S.C. § 101. Accordingly, the Office is respectfully requested to reconsider and withdraw the rejection of claims 13-18 under 35 U.S.C. § 101.

In addition, the Office has rejected claims 1-12, and "29-21" are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,101,532 to Horibe (Horibe). To the extent that the Examiner intended to reject claims 1-12, and 19-21, which is presumed based on the detailed statements of rejection on pages 3-10 of the Office Action, Applicants submit the following.

As per claims 1, 7, and 19, the Office asserts that Horibe discloses determining one or more related electronic messages to a new electronic message (see figs. 3A-3d and col. 7, lines 35-57); assembling (merging) the one or more related electronic messages (see col. 5, lines 12-16 and col. 8, lines); and displaying a portion of the one or more related electronic messages (see fig. 4 and col. 2, lines 40-54 and col. 7, lines 35-58, where when reply bottom

is selected related messages are displayed). The Office states that Horibe is silent regarding non-disruptively displaying the one or more related message, but asserts that non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system.

Furthermore, the Office asserts that Horibe teaches a related message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58). Hence, the Office asserts that, by displaying a message tree of related messages without extra steps to see the related messages, one skilled in the art would have readily recognized Horibe non-disruptively displays one or more related messages.

However, Horibe does not teach or suggest an electronic message management system comprising "a message display device that nondisruptively and automatically displays a portion of the one or more related electronic messages" as recited by claim 1, an electronic message management method comprising "nondisruptively and automatically displaying a portion of the one or more related electronic messages" as recited by claim 7, and an electronic message management system comprising "an output device adapted to nondisruptively and automatically communicate the related electronic messages" as recited by claim 19.

To the contrary, Horibe teaches a standard indented view of a message thread, with the ability to select and view messages within that thread. In particular, the portions of Horibe cited by the Office at Col. 4, lines 49-54, teach that a "display screen can be displayed for the electronic conference system by using the user client in response to a request of the participant of the conference." Thus, contrary to the present invention, users of Horibe's system must execute the additional step of selecting to have the message relations list displayed. Moreover, the system taught by Horibe does not enable or render obvious any system wherein electronic messages related to a new electronic message are identified and portions of the related electronic messages are nondisruptively and automatically displayed. In this regard, even if a user of Horibe's system desires to have portions of related messages identified and then displayed, the teachings of Horibe provide that the user must take additional steps to achieve this result, and fail to suggest the advantageous nondisruptive and automatic display as recited in claims 1, 7, 13, and 19.

As provided on page 3, line 13, to page 4, line 3, of the Specification, the electronic message management systems and methods of the present application use a two operation process for nondisruptively searching and displaying conversationally-related messages. Specifically, the first operation involves finding messages having data that is conversationally related to a message in preparation. More particularly, the first operation involves detecting that a user is composing a new message and collecting pieces of information pertaining to that new message that will allow for conversationally-related messages to be discovered. For example, the destination address and the subject line could be particularly salient in discovering conversationally-related messages. Next, the related messages must be found. This is accomplished by performing, for example, a background search over all saved electronic messages for any messages that were sent, for example, to the destination addressees, or were cc'd to the destination address, or, for example, that were received from the destination address. If the destination address is known to belong to a person with multiple addresses, the search may be, for example, extended to those addresses as well. Additionally, the search can discover items that have the same subject line as a message being composed. Furthermore, if a conversational thread includes many participants, the search can find related messages that may or may not be to or from the newly targeted recipient. Secondly, the discovered messages are presented in a nondisruptive manner to the user. This involves presenting the discovered items to the user in such a way as to be nondisruptive. One option is to assemble all of the found messages into a separate electronic message folder. Alternatively, for example, the found electronic messages can be displayed in the periphery of a display, or, for example, presented in a list of found items in a separate display, such as a graphical user interface. For each of these instances, the user is advantageously not distracted from the task at hand, i.e., composing an electronic message.

Accordingly, in view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 1, 7, 13, and 19. Since claims 2-6 and 22-23 depend from and contain the limitations of claim 1, claims 8-12 and 24-25 depend from and contain the limitations of claim 7, claims 14-18 and 26-27 depend from and contain the limitations of claim 13, and claims 20-21 and 28-29 depend from and contain the limitations of claim 19, they are patentable in the same manner as claims 1, 7, 13, and 19.

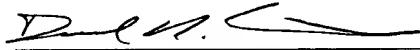
from and contain the limitations of claim 19, they are patentable in the same manner as claims 1, 7, 13, and 19.

Finally, while Applicants now believe this case is in condition for allowance, the Office's attention is respectfully directed to the fact that this Office Action was not fully responsive to the Amendment filed August 4, 2004. In particular, the Office failed to consider all of claims 1-29 pending in this application prior to the issuance of the Office Action. Specifically, claims 22-29, which were added to the present application in the Amendment of August 4, 2004, were not considered by the Office, as evidenced by the statement of the Disposition of Claims on the Office Action Summary which recites that claims 1-21 are pending in the application. Therefore, an Examiner Interview was conducted by telephone on April 22, 2005 with Examiner Salad, in which this error was discussed. Examiner Salad acknowledged the error, and stated that, if an additional Office Action is found to be necessary in this application, the next action would be a non-final Office Action in which all of claims 1-29 would be considered.

However, as stated above, Applicants believe that this case is currently in condition for allowance in view of all of the foregoing, and earnestly solicit an indication of such allowance. In the unlikely event the Office determines that additional examination is required, Applicants expect that the next communication will have a non-final status to provide Applicants with an opportunity to respond completely.

Respectfully submitted,

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